

REMARKS

I. STATUS OF THE CLAIMS

Claims 1 – 9 are pending. Claims 10 – 51 have been withdrawn.

II. OBVIOUSNESS REJECTIONS

Claims 1 to 3 and 6 to 9 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of U.S. Patent No. 5,344,483 to Hinton et al. (the '483 patent). In addition, claims 4 and 5 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of the '483 patent and U.S. Patent No. 5,897,694 to Woolf (the '694 patent). Applicant respectfully traverses this rejection because neither of these references teach, either expressly or implicitly, all of the elements of the claimed invention. More particularly, neither Hinton nor Woolf teaches adding a diluent to a viscous printing composition having a Brookfield viscosity in excess of 100 cps at 25 °C.

To establish a *prima facie* case of obviousness the cited reference or combination of references must teach all of the claimed limitations of the invention. MPEP 2143.03. The Office acknowledges that the cited reference is silent with respect to this limitation, but nevertheless argues that since oleate-based inks can be used in impact printing processes (e.g., printer ribbon inks), the inks of Hinton implicitly have a viscosity of at least 100 cps at 25 °C. This conclusion, however, is contradicted by the actual teaching of Hinton which clearly indicates that the invention is directed to “an ink composition suitable for ink jet printing.” (See Hinton, abstract). For at least this reason, the Office’s rejection is respectfully traversed.

Notwithstanding applicant’s traversal of the rejections, a request to suspend examination of the application has been filed in order to generate data supporting the patentability of the claimed invention.

III. CONCLUSION:

In view of the foregoing remarks, applicants assert that the present claims are in condition for allowance. The Office is invited to contact Applicants' undersigned counsel by telephone in order to further the prosecution of this case in any way.

Respectfully submitted,

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